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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/506,721	01/24/2005	Richard Martin	980049.402USPC	5175
63572	7590	05/07/2008	EXAMINER	
MCDONNELL BOEHNEN HULBERT @ BERGHOFF LLP			TRUONG, TAMTHOM NGO	
300 SOUTH WACKER DRIVE			ART UNIT	PAPER NUMBER
SUITE 3100			1624	
CHICAGO, IL 60606				

  

MAIL DATE	DELIVERY MODE
05/07/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/506,721	MARTIN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	TAMTHOM N. TRUONG	1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 1-24-05 (Pre. Amdt).
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) See Continuation Sheet is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ .  | 6) <input type="checkbox"/> Other: _____ .                        |

Continuation of Disposition of Claims: Claims pending in the application are 1-7, 10, 11, 15-22, 25-31, 33, 34, 36, 37, 39-43, 45, 46, 48-51, 53-56, 58, 59, 61, 62, 64, 65, 67-69, 71, 72, 74-76, 78, 80, 81, 83, 99-101 and 103.

Continuation of Disposition of Claims: Claims rejected are 1-7, 10, 11, 15-22, 25-31, 33, 34, 36, 37, 39-43, 45, 46, 48-51, 53-56, 58, 59, 61, 62, 64, 65, 67-69, 71, 72, 74-76, 78, 80, 81, 83, 99-101 and 103.

Applicant's preliminary amendment of 1-24-05 has been entered.

Claims 8, 9, 12-14, 23, 24, 32, 35, 38, 44, 47, 52, 57, 60, 63, 66, 70, 73, 77, 79, 82 and 102 have been cancelled.

Claims 1-7, 10, 11, 15-22, 25-31, 33, 34, 36, 37, 39-43, 45, 46, 48-51, 53-56, 58, 59, 61, 62, 64, 65, 67-69, 71, 72, 74-76, 78, 80-81, 83-101 and 103 are pending.

### *Election/Restrictions*

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

**Group I:** claim(s) 1-7, 10, 11, 22, 25, 27-31, 33, 34, 36, 37, 39-43, 45, 46, 48-51, 99-101 and 103, drawn to compounds of **formula III** which is a subgenus of formula I wherein:

- $R^1$  is an optionally substituted phenyl group;
- One of  $R^4$  and  $R^5$  is  $-S(O)_jR^{11}$ ;
- Wherein  $j = 2$ , and  $R^{11}$  is an optionally substituted aryl group;
- Two of  $R^{1a}$  or  $R^3$  do **not** form a ring.

And pharmaceutical composition thereof; classified in class 514, subclass 266.3, and class 544, subclass 287.

**Group II:** claim(s) 1, 2, 15-22, 25-31, 33, 34, 36, 37, 39, 53-56, 58, 59, 61, 62, 64, 65, 67-69, 71, 72, 74, 75, 76, 78, 99 and 100, drawn to compounds of **formula V** which is a subgenus of formula I wherein:

- $R^1$  is an optionally substituted phenyl group;
- One of  $R^4$  and  $R^5$  is  $-C(E)R^{23}$ ;
- Wherein E is oxygen and  $R^{23}$  is an optionally substituted aryl group.
- Two of  $R^{1a}$  or  $R^3$  do **not** form a ring;

And pharmaceutical composition thereof; classified in class 514, subclass 266.3, and class 544, subclass 287.

**Group III:** claim(s) 1, 2, 5, 7, 10, 11, 22, 25-31, 33, 34, 36, 37, 39, 80, 81, 83, 99, 100 and 101, drawn to the remaining compounds of formula I which are not in the above groups (e.g., those with R<sup>1</sup> as an optionally substituted alkyl, alkenyl, alkynyl group, etc.), classified in classes 514 and 544, various subclasses. Further restriction and/or election of species will be required if this group is elected.

**Group IV:** claim(s) 84-98, drawn to a method of treating, preventing or ameliorating the symptoms of several diseases using a compound of formula I, classified in classes 514 and 544, various subclasses. Further restriction and/or election of species will be required if this group is elected.

The inventions of groups I – III are independent and distinct as they have different groups at the 2-position of the quinazolinone ring. Although both groups share the quinazolinone as a core, such a core does not define a contribution over the prior art, i.e., it can be anticipated by or obvious in view of the prior art.

Inventions of Group IV and (I-III) are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the claimed method of treatment can use any commercially available drugs. The subcombination has separate utility such as anticancer agent as evident by **Finer et. al.** (US 7,294,634 B2).

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found

allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

**Applicant is advised that the reply to this requirement to be complete must include**

**(i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically

point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

**Rejoinder Conditions:** The examiner has required restriction between product and method claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn method claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Method claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined method claims will be withdrawn, and the rejoined method claims **will be fully examined for patentability in accordance with 37 CFR 1.104**. Thus, to be allowable, **the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112**. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and method claims may be maintained. Withdrawn method claims that are not commensurate in scope with an allowed product claim will not be rejoined. See “Guidance on Treatment of Product and Process Claims in light of In re Ochiai, In re Brouwer and 35 U.S.C. § 103(b),” 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the method claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Due to the complicated nature of the claims and chemical structure, the restriction is presented in writing.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

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application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAMTHOM N. TRUONG whose telephone number is (571)272-0676. The examiner can normally be reached on M, T and Th (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Tamthom N. Truong/

*Tamthom N. Truong*  
*Examiner*  
*Art Unit 1624*

**/James O. Wilson/**  
**Supervisory Patent Examiner, Art Unit 1624**

4-28-08